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PTO/SB/21 (05-03)
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

| | |
|------------------------|------------------------|
| Application Number | 10/034,826 |
| Filing Date | December 28, 2001 |
| First Named Inventor | Garrett Holmes, et al. |
| Art Unit | 2832 |
| Examiner Name | Lincoln Donovan |
| Attorney Docket Number | DKT 00054A (BWI-00055) |

Total Number of Pages in This Submission

ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment/Reply | <input checked="" type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Request for Refund | Return Receipt Postcard |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> CD, Number of CD(s) _____ | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | Remarks | |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application | Applicant believes no fee to be due for the attached filing, however, should additional fees be due in order to prevent the abandonment of this application, please consider this as authorization to charge Deposit Account No. 501612 (Warn, Hoffmann, Miller & LaLone, P.C.) for any such fees due. A duplicate copy of this document is enclosed for this purpose. | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------|---|
| Firm or Individual name | Warn, Hoffmann, Miller & LaLone, P.C. Philip R. Warn - Reg No. 32775 |
| Signature | <i>[Signature]</i> |
| Date | June 27, 2005 |

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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| Typed or printed name | Philip R. Warn - Reg. No. 32775 | | |
| Signature | <i>[Signature]</i> | Date | June 27, 2005 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/034,826
Filing Date: December 28, 2001
Applicant: Garrett Holmes, et al.
Group Art Unit: 2832
Examiner: Lincoln Donovan
Title: VARIABLE BLEED SOLENOID
Attorney Docket: DKT 00054A (BWI-00055)

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop
Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

June 27, 2005. By: [Signature]

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
BASED ON FAILURE TO RECEIVE OFFICE ACTION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Notice of Abandonment mailed May 25, 2005. The Applicant respectfully requests that the holding of abandonment be withdrawn based on the failure of the Applicants to receive the Office Action mailed October 18, 2004.

A review of the U.S. Patent and Trademark Office's PAIR system indicates the following:

(1) That an Office Action was apparently mailed to the Applicants last known address (see Exhibit A).

(2) However, the envelope containing the Office Action apparently did not contain any such address (or any address whatsoever for that matter) printed thereon (see Exhibit B).

(3) As Exhibit B indicates, as there was no apparent addressee, the U.S. Post Office was unable to deliver the Office Action to the Applicant, as indicated by the stamp "Not Deliverable as Addressed UNABLE TO FORWARD."

(4) Therefore, the Applicants, nor their attorneys and/or agents, ever received a copy of the Office Action as it was never delivered by the U.S. Post Office.

Accordingly, it is respectfully requested that the Office Action be re-mailed to the Applicants new address, which the U. S. Patent and Trademark Office was recently apprised of (see Exhibit C), namely:

BorgWarner Inc.
Patent Administrator
3850 Hamlin Road
Auburn Hills, MI 48326-2872

and that the period for response be recalculated from the date of the re-mailing.

CONCLUSION

It is respectfully submitted that, in view of the above remarks, the Office Action previously mailed October 18, 2004 be re-mailed and the period for response thereto be recalculated from the date of the re-mailing.

As set forth above it is believed this error occurred because of a USPTO error. However, if for some reason Applicant is found to be at fault, please consider this a petition to revive under 37 CFR § 1.137, charging any fees necessary to the deposit account below.

The Examiner is invited to telephone the applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 501612. A duplicate copy of this letter is enclosed herewith for this purpose.

Respectfully submitted,

WARN, HOFFMANN, MILLER & LALONE, P.C.
Attorneys for Applicant(s)

Dated: June 27, 2005

By: 

Philip R. Warn
Reg. No. 32775
Preston H. Smirman
Reg. No. 35365

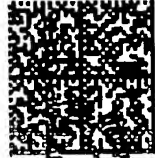
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JUN 29 2005

PATENT & TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------------|------------------|
| 10/034,826 | 12/28/2001 | Garrett Holmes | DKT 00054A (BW1-00055) | 1464 |

7590

10/18/2004

Patent Docket Administrator
BorgWarner Inc.
3001 West Big Beaver Rd. - Suite 200
P.O. Box 5060
Troy, MI 48007-5060

EXAMINER

DONOVAN, LINCOLN D

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

10/034,826

HOLMES ET AL.

Examiner

Art Unit

Lincoln Donovan

2832

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) 9-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perach [US 4,538,645] in view of Hamilton et al. [US 5,707,039] and Miki et al. [US 5,135,027].

Regarding claim 1, Perach discloses a control valve assembly comprising:

- a housing [40] defining an internal chamber therein;
- an electromagnetic coil [22] wound on a bobbin [38] coaxially mounted within the housing;
- an axially movable armature [72], having first and second ends, mounted in the internal chamber;
- an actuation member [74] extending from the armature;
- a pole piece [46] operably associated with the armature;
- a valve manifold [12] including control passages [16, 18];
- first and second valve seats [figure 3];
- a valve [66] positioned for selectively sealing on the first or second valve seats;
- a spring [76] for biasing the armature; and

Art Unit: 2832

- control means [column 5, line 57-column 6, line 14].

Perach discloses the instant claimed invention except for a flux tube partially surrounding the armature, the valve using a ball cooperating with the actuator operable between a supply side seat and an exhaust side seat.

Hamilton et al. disclose a hydraulic solenoid having an armature [41] interacting with a flux tube [33].

It would have been obvious to a person having ordinary skill in the art at the time invention was made to use the flux tube design with the pole piece of Perach, as suggested by Hamilton et al., for the purpose of increasing activation force.

Claims 4-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perach, as modified, as applied to claim 1 above, and further in view of Barkhimer et al. [US 5,752,689].

Perach, as modified, disclose the instant claimed invention except for the valve being a ball valve.

Miki et al. disclose a solenoid valve assembly having a ball type valve [68, figure 4b] operable between a supply side seat [66a] and an exhaust side seat [66c].

It would have been obvious to a person having ordinary skill in the art at the time invention was made to use a ball type valve design of Barkhimer et al. for the valve of Perach, as modified, for the purpose of maintaining a superior seal.

Regarding claims 2 and 6-7, the specific control functions, bias states and valve positioning would have been an obvious design consideration dependent upon the specific application of the hydraulic valve.

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Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

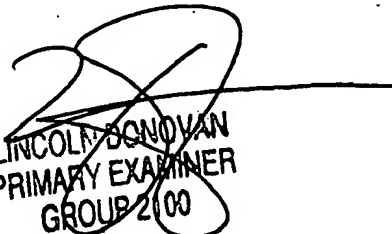
Conclusion

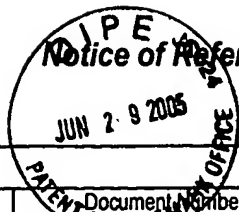
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is 571-272-1988. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ldd


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100

**Notice of References Cited**

Application/Control No.

10/034,826

Applicant(s)/Patent Under
Reexamination
HOLMES ET AL.

Examiner

Lincoln Donovan

Art Unit

2832

Page 1 of 1

U.S. PATENT DOCUMENTS

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|---|--|-----------------|-------------|----------------|
| | A | US-5,135,027 | 08-1992 | Miki et al. | 137/596.17 |
| | B | US- | | | |
| | C | US- | | | |
| | D | US- | | | |
| | E | US- | | | |
| | F | US- | | | |
| | G | US- | | | |
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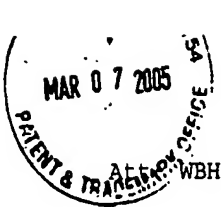
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NON-PATENT DOCUMENTS

| * | | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
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| | U | |
| | V | |
| | W | |
| | X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/034826

Filing Date: 28DE2001

Docket Number: DKT00054A US.PC.NO 1464

In Re Application Of: Holmes Garrett R

Title: VARIABLE BLEED SOLENOID

CHANGE OF CORRESPONDENCE ADDRESS

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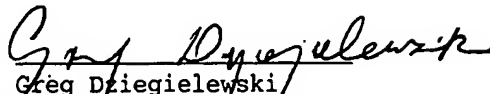
Dear Sir/Madam:

Please change the Correspondence Address for the above-identified application to:

BorgWarner Inc.
Patent Administrator
3850 Hamlin Road
Auburn Hills, MI 48326-2872

and direct all Patent Office communications and Letters Patent, when granted, to this address.

Respectfully submitted,


Greg Dziegielewski
Attorney of Record
Reg. No. 28,073

March 04, 2005
Main Telephone: (248) 754-9200